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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,550	09/09/2003	Alan Weiss	MCA-623 US	3075

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,550

Applicant(s)

WEISS ET AL.

Examiner

Krishnan S. Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1,4-6 and 14-21 are pending in the RCE of 9/6/06.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Root et al (US 4,948,564).

Root'564 teaches a filtration plate (18-figure 8) with a filter in the bottom of each well (18), a collection plate (122) with wells (140), and an evaporation control device in the form of a plastic sheet (120) having holes (136) which register with the wells of the filter plate and the collection plate, a hole for each of the wells, as claimed. See column 3 lines 3-32. The device is associated with a centrifuge (column 6 lines 56-68).

Claim 20 recites the process using the multiwell filter described above, which Root'564 teaches in column 6 lines 56-68.

Applicant's remark of 9/6/06 about the Root'564 reference, that nozzle 134 in sheet 120 provides a slight clearance for venting gases built up, was considered, but not persuasive because it is not commensurate in scope with the claims in that claims do not recite that the evaporation control device make a leak-tight joint. The plastic sheet 120 of Root is capable of providing evaporation control, like a lid on a water

Art Unit: 1723

container; the clearance is to allow air (gas) displaced by the filtrate to escape when the filtrate fills the wells 140.

2. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Dunnington et al (US 6,376,256).

Dunnington teaches a gasket sheet (17) sealing between the upper and lower wells (40 and 45) with holes larger than at least the well or capillary 40 – see figure 5. Upper well is a filter – it retains the beads. The system is useful with a centrifuge. See abstract and paragraph linking column 6 and 7.

Applicant's remarks of 9/6/06 are not persuasive. The filter (40) does seal across the bottom of the wells of filter plate (42) so that "...any fluid exiting the wells must pass through the filter" as recited in the claim. The system is useful with a centrifuge as taught in the abstract. The gasket provides the seal (column 6 lines 59-61) like the applicant's figure 2, which appears to be the embodiment claimed in the claim.

3. Claims 1,20, are rejected under 35 U.S.C. 102(b) as being anticipated by Sanadi (US 5,342,581).

Sanadi teaches (figure 11, and claims) wells (246) with filter (228), collections plate (192), gaskets (204,240), and lid (236) as claimed. The filter plate is suitable for centrifuge (column 3 lines 50-54).

The multiwell plates are intended for filtration process in which the evaporation and cross-contamination are reduced (see column 1 lines 5-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5,6, 14-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Root'564 as applied to claim 1 above and further in view of Root (US 5,650,323) or Guhl et al (US 4,657,867).

Instant claims, including independent claim 19, recite the filter plate, the well plate, the evaporation control device between the filter plate and the well plate and the cover on the filter plate. With respect to Claim 14, the interface formed is the sheet 120. The claims differ from the teaching of Root'564 in the recitation of the "cover" which covers the top of the filter plate, and which has a skirt that extends down to the collection plate in the bottom.

Claim 21 is a "Jepson" claim, and therefore the preamble of claim 21 is admitted prior art for all the pending claims. The preamble part of claim 21 is taught by Root as above, and the sheet material.

Root'323 teaches a cover with a skirt as claimed in figure 14 in a multiwell filtration plate system. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Root'323 in the teaching of Root'564, or in the applicant's admission of prior art in claim 21, for the cover because the cover of

Art Unit: 1723

Root'323 would keep the system from evaporation losses, and particularly, the cover of Root'323 in figure 14 having drip rings matching each well that would maintain sterility and evaporation control. See column 4 lines 4-8 and column 5 lines 34-39 of Root'323.

Guhl teaches that a cover of multiwell plates is well known, and is used for the advantages such as sterility, prevent cross-talk and maintain ventilation (see column 1 lines 25-53), and that Guhl's teaching of a cover with a skirt has advantages over the known cover plates (see column 2 lines 40-57 and figures). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Guhl in the teaching of Root'564, or in the applicant's admission of prior art, to have the cover for the advantages as taught by Guhl.

The distance to which the skirt of the cover need to extend would be within the purview of one of ordinary skill in the art to design, to obtain sufficient closure with the cover. See in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunnington.

The hole in the gasket in Dunnington is at least larger than the capillary well 40, and appears the same size as the bottom well, and so differs from the recitation of claim 4 in that respect. However, it would be obvious to one of ordinary skill in the art at the time of invention that the hole-size in Dunnington can be selected to have the upper well descending into the lower well. Actual size of the hole would be a matter within the capability of one of ordinary skill in the art to design. See in *Gardner v. TEC Systems*,

Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Applicant's remarks of 9/6/06 are not persuasive: if hole size is important for centrifugal applications to minimize the space between the wells, how would holes in the gasket being larger than the holes in the well help? For providing maximum (gasket) coverage of the interface between the wells, hole size in the gasket and the wells should be equal, not larger.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanadi.

The claim differs from the reference in that the hole in the gasket is the same as that of the wells. However, actual size of the hole would be a matter within the capability of one of ordinary skill in the art to design. See in Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

7. Claims 5,6, 14-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanadi as applied to claim 1 above and further in view of Root (US 5,650,323) or Guhl et al (US 4,657,867).

Instant claims differ from Sanadi in the down-wardly extending top cover. Sanadi teaches a top cover, which is not downwardly extending. The interface between the well and the collection plate in claim 14 would be the gasket (204). Both Root and Guhl teach downwardly extending top covers which are easier to install than the clamped

Art Unit: 1723

cover of Sanadi. In addition, both Root and Guhl teach good evaporation control using the covers (Guhl column 1 lines 25-53, Root column 4 lines 4-8). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Guhl or Root because of the advantages as taught by Guhl (see column 2 lines 40-57), or Root (column 4 lines 4-8). Regarding the length of extension of the skirt, the distance to which the skirt of the cover need to extend would be within the purview of one of ordinary skill in the art to design, to obtain sufficient closure with the cover. See in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Response to Arguments

Arguments submitted on 9/6/06 are not persuasive. Most of the arguments are addressed in paragraphs following the art rejections.

With respect to the Jepson claim 21, the preamble of the claim is admitted prior art (MPEP 2129).

With respect to the arguments about the 103 rejection, the office action does not suggest that figure 14 of Root 564 be modified with Root 323, as argued. Usage of covers is well known in the art as shown by Guhl. Moreover, the reference clearly teaches the covers are provided for controlling evaporation while allowing for gas exchange and maintaining sterility. Therefore, applicant's argument that 'the office action is asking the skilled artisan would ignore the Root '564 disclosure regarding the

Art Unit: 1723


use of a device that allows for gas to escape ...' is misplaced. Regarding the Guhl reference, it clearly teaches "evaporation control" in column 1 lines 25-53.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Krishnan S Menon
Examiner
Art Unit 1723
9/14/06